

## **REMARKS**

### **I. Prosecution History**

Claims 1-13 were presented for examination by Applicant's filing of a nonprovisional application on January 16, 2004. Under the first non-final Office Action, dated October 4, 2007, claims 1-13 were rejected under 35 U.S.C. 102(e) as being anticipated by Murren et al. (US Pub No 2003/0110085). Applicant amended claims 1, 6, 12 and 13 and requested reconsideration of the application.

Claims 1-13 were then finally rejected in a final Office Action, dated April 29, 2008, under 35 U.S.C. §103(a) as being unpatentable over Murren (US Pub No. 2003/0110085) in view of Marks (2002/0007374). Applicant cancelled claims 7 and 8 and amended claims 6, 9, 10, 11 and 12 to place the application in condition for allowance.

Under the Office Action, dated July 24, 2008, claims 1-13 were rejected and the amendments to claims 6 and 12 were not entered. The Examiner maintained the rejection to claims 1-13 under 35 U.S.C. §103(a) as being unpatentable over Murren in view of Marks. Applicant filed a Request for Continued Examination.

Under the current non-final Office Action, dated December 3, 2008, the finality of the previous office action is withdrawn and amendments submitted by Applicant on August 28, 2008, have been entered. Claims 1-13 stand rejected as being unpatentable over Murren in view of Marks.

Applicant herein submits a request for reconsideration of his application given the following amendments and arguments.

### **II. Claim Objection**

Claim 15 was objected to because it depends on cancelled claim 7. Applicants herein amend claim 15 to properly depend from claim 9. Based on the foregoing, withdrawal of the objection is respectfully requested.

### **III. Claim Rejections – 35 U.S.C. §103**

#### ***Requirements for Prima Facie Obviousness***

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

"The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness."

The U.S. Supreme Court ruling of April 30, 2007 (KSR Int'l v. Teleflex Inc.) states:

"The TSM test captures a helpful insight: A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. Although common sense directs caution as to a patent application claiming as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does."

"To facilitate review, this analysis should be made explicit."

The U.S. Supreme Court ruling states that it is important to identify a reason that would have prompted a person to combine the elements and to make that analysis explicit. MPEP §2143 sets out the further basic criteria to establish a prima facie case of obviousness:

1. a reasonable expectation of success; and
2. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

It follows that in the absence of such a prima facie showing of obviousness by the examiner (assuming there are no objections or other grounds for rejection) and of a prima facie showing by the examiner of a reason to combine the references, an applicant is entitled to grant of a patent. Thus, in order to support an obviousness rejection, the examiner is obliged to produce evidence compelling a conclusion that the basic criterion has been met.

### ***Murren in view of Marks***

Claims 1-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Murren (US Pub No. 2003/0110085) in view of Marks (US Pub No. 2002/0007374) and the background of the invention.

Regarding claim 1, the Examiner argues that Murren discloses maintaining synchronization of information published to multiple subscribers, comprising: publishing print-ready document library subject availability via multicast communication over a data network using a multicast communication transport layer; receiving subscriptions for print-ready document library subjects via point-to-point data communication over the data network from remote subscribers at individual sites; and instantaneously, at time of repository change, synchronizing data representative of the print-ready document with remote subscribers at individual sites over the data network using a multicast communication transport layer.

However, while Murren fails to disclose a data network using a multicast communication transport layer, the Examiner argues that Marks discloses a data network using a multicast communication transport layer. And while neither Murren nor Marks teach print-ready document, this is well known in the art as evidenced by the background of the invention. Also, the Examiner argues that the background of the invention discloses already print formatted mater documents that may be transmitted to a printer directly, which eliminates a need to repeat conversion and decomposition process of another copy if desired. Therefore, the Examiner argues, it would have been obvious to one of ordinary skill at the time of invention to have a print ready document incorporated in the device of Murren, as modified by the features of Marks, in order to eliminate the need to repeat the conversion or decomposition process if another copy of the document is needed.

The Applicant respectfully disagrees with this assessment and submits that claim 1 is herein amended to include "maintaining a records of subscriber data, subject data and publication-subscription logs utilizing a publish-subscribe middleware wherein said publish-subscribe middleware enables at least one server and at least one database to operate together for management of said records". The Applicant further submits that neither Murren, Marks nor the background of

Applicant's application disclose any sort of middleware or similar means of maintaining and managing records of subscriber data, subject data and publication-subscription logs. Thus, because Murren, Marks and the background all fail to disclose or suggest all of the limitations of Applicant's claim 1, the rejection fails to meet the requirements for *prima facie* obviousness as discussed above.

Additionally, the Applicant submits that while the Examiner has provided a motivation for creation of Applicant's device, an explicit analysis of a reasonable expectation of success in combining the references to achieve Applicant's device has not been provided. Applicant further submits that success is highly unlikely because Marks teaches away from the general principles of Applicant's device. The teachings of Mark relate to delivery of a document or file upon request by a first computer (Marks paragraphs [0008-0010]), which is significantly different from the automatic delivery method of Applicant's device. In fact, Applicant's device specifically avoids the need to request a document, and instead provides automatic delivery of documents that are of particular interest to a user based on predefined subjects. Therefore, it is unlikely that one having ordinary skill in the art at the time of invention would have been successful in modifying the teachings of Murren with the teachings of Marks to successfully achieve Applicant's device as claimed. Thus, because the Examiner has failed to provide an explicit analysis regarding a reasonable expectation of success and because Marks teaches away from Applicant's device, the rejection fails to meet the requirements for *prima facie* obviousness.

Based on the foregoing, the Applicant submits that the rejection to claim 1 is traversed and withdrawal of the rejection is respectfully requested.

Regarding claim 2, the Examiner argues that Murren discloses the method of claim 1 wherein jobs are assigned to subjects. The Applicant respectfully disagrees with this assessment and submits that the arguments presented above regarding claim 1 apply equally to the rejection of dependent claim 2. As such, the Applicants submit that the rejection of claim 2 has been traversed and withdrawal of the rejection is respectfully requested.

Regarding claim 3, the Examiner argues that Murren discloses the method of claim 2 wherein said jobs include documents. The Applicant respectfully disagrees

with this assessment and submits that the arguments presented above regarding claim 1 apply equally to the rejection of dependent claim 3. As such, the Applicants submit that the rejection of claim 3 has been traversed and withdrawal of the rejection is respectfully requested.

Regarding claim 4, the Examiner argues that Murren discloses the method of claim 3 wherein said jobs are documents. The Applicant respectfully disagrees with this assessment and submits that the arguments presented above regarding claim 1 apply equally to the rejection of dependent claim 4. As such, the Applicants submit that the rejection of claim 4 has been traversed and withdrawal of the rejection is respectfully requested.

Regarding claim 5, the Examiner argues that Murren discloses the method of claim 1, wherein remote subscribers at individual sites interested in a subject can subscribe to the subject and receive document updates automatically wherein only necessary data related to the subject is synchronized with the remote subscribers at specific sites. The Applicant respectfully disagrees with this assessment and submits that the arguments presented above regarding claim 1 apply equally to the rejection of dependent claim 5. As such, the Applicants submit that the rejection of claim 5 has been traversed and withdrawal of the rejection is respectfully requested.

Regarding claim 6, the Examiner argues that Murren discloses maintaining synchronization of information published to multiple subscribers, comprising: publishing print-ready document library subject availability via multicast communication over a data network using a multicast communication transport layer; and receiving subscriptions for print-ready document library subjects over the data network via –point-to-point data communication from remote subscribers at individual sites. However, Murren fails to teach a data network using a multicast communication transport layer, but this is well known in the art as evidenced by Marks. The Examiner further argues that Marks discloses a data network using a multicast communication transport layer, therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to have the feature of a data network using a multicast communication transport layer in order to have a one-to-many transmission protocol.

The Examiner also argues that Murren and Marks fail to teach a print ready document, but that this is well known in the art as evidenced by the background of the invention which discloses a print ready document. Therefore, in view of the background of the invention it would have been obvious to one of ordinary skill at the time of invention to have a print ready document incorporated in the device of Murren, as modified by Marks, in order to eliminate the need to repeat the conversion or decomposition process if another copy of the document is needed.

The Applicant respectfully disagrees with this assessment and submits that claim 6 is herein amended to include "maintaining a records of subscriber data, subject data and publication-subscription logs utilizing a publish-subscribe middleware wherein said publish-subscribe middleware enables at least one server and at least one database to operate together for management of said records". The Applicant further submits that neither Murren, Marks nor the background of Applicant's application disclose any sort of middleware or similar means of maintaining and managing records of subscriber data, subject data and publication-subscription logs. Thus, because Murren, Marks and the background all fail to disclose or suggest all of the limitations of Applicant's claim 6, the rejection fails to meet the requirements for *prima facie* obviousness as discussed above.

Additionally, the Applicant submits that while the Examiner has provided a motivation for creation of Applicant's device, an explicit analysis of a reasonable expectation of success in combining all of the references to achieve Applicant's device has not been provided. Applicant further submits that success is highly unlikely because Marks teaches away from the general principles of Applicant's device. The teachings of Mark relate to delivery of a document or file upon request by a first computer (Marks paragraphs [0008-0010]), which is significantly different from the automatic delivery method of Applicant's device. In fact, Applicant's device specifically avoids the need to request a document, and instead provides automatic delivery of documents that are of particular interest to a user based on predefined subjects. Therefore, it is unlikely that one having ordinary skill in the art at the time of invention would have been successful in modifying the teachings of Murren with the teachings of Marks to successfully achieve Applicant's device as claimed. Thus, because the Examiner has failed to provide an explicit analysis regarding a

reasonable expectation of success and because Marks teaches away from Applicant's device, the rejection fails to meet the requirements for *prima facie* obviousness.

Based on the foregoing, the Applicant submits that the rejection to claim 6 is traversed and withdrawal of the rejection is respectfully requested.

Regarding claim 9, the Examiner argues that Murren discloses the method of claim 6 wherein said jobs include documents. The Applicant respectfully disagrees with this assessment and submits that the arguments presented above regarding claim 6 apply equally to the rejection of dependent claim 9. As such, the Applicants submit that the rejection of claim 9 has been traversed and withdrawal of the rejection is respectfully requested.

Regarding claim 10, the Examiner argues that Murren discloses the method of claim 6 wherein said jobs are documents. The Applicant respectfully disagrees with this assessment and submits that the arguments presented above regarding claim 6 apply equally to the rejection of dependent claim 10. As such, the Applicants submit that the rejection of claim 10 has been traversed and withdrawal of the rejection is respectfully requested.

Regarding claim 11, the Examiner argues that Murren discloses the method of claim 6 wherein remote subscribers at individual sites interested in a subject can subscribe to the subject and receive updates automatically wherein only the necessary data related to the subject is synchronized with the remote subscribers at specific sites. The Applicant respectfully disagrees with this assessment and submits that the arguments presented above regarding claim 6 apply equally to the rejection of dependent claim 11. As such, the Applicants submit that the rejection of claim 11 has been traversed and withdrawal of the rejection is respectfully requested.

Regarding claim 12, the Examiner argues that Murren discloses maintaining synchronization of information published to multiple subscribers comprising: at least one server having access to a data network supporting point-to-point data communication and also supporting multicasting over a multicast communication transport layer; at least one database containing print-ready documents associated with a print ready document library and the print ready document library; and

software contained in at least one of server, said software for: managing the publication of print ready document library information to multiple subscribers over the data network using a multicast communication transport layer, accepting print-ready document library subscription from the multiple subscribers point-to-point data communication, and synchronization of print ready document library and documents associated with the library with the multiple subscribers from the database through the server and the network point-to-point data communication to multiple subscriber equipment.

Therefore, the Examiner argues, that in view of Marks, it would have been obvious to one having ordinary skill in the art at the time of invention to have the feature of a data network also supporting multicasting over a multicast communication transport layer in order to have a one-to-many transmission protocol. However, Murren and Marks fail to teach print ready document, but the background of the invention discloses print ready documents. Also, the background of the invention sends information over a network to other devices, then the background is viewed as similar to the other applied references above. Also, the background of the invention discloses already print formatted master documents that may be transmitted to a printer directly, which eliminates a need to repeat conversion and decomposition process of another copy if desired. Therefore, the Examiner argues it would have been obvious to one having ordinary skill in the art at the time of invention to have a print ready document incorporated in the device of Murren, as modified by the features of Marks, in order to eliminate the need to repeat need to repeat the conversion or decomposition process if another copy of the document is needed.

The Applicant respectfully disagrees with this assessment and submits that claim 12 is herein amended to include "a publish-subscribe middleware wherein said publish-subscribe middleware enables at least one server and at least one database to operate together for management of records of subscriber data, subject data and publication-subscription logs". The Applicant further submits that neither Murren, Marks nor the background of Applicant's application disclose any sort of middleware or similar means of maintaining and managing records of subscriber data, subject data and publication-subscription logs. Thus, because



Murren, Marks and the background all fail to disclose or suggest all of the limitations of Applicant's claim 12, the rejection fails to meet the requirements for *prima facie* obviousness as discussed above.

Additionally, the Applicant submits that while the Examiner has provided a motivation for creation of Applicant's device, an explicit analysis of a reasonable expectation of success in combining all of the references to achieve Applicant's device has not been provided. Applicant further submits that success is highly unlikely because Marks teaches away from the general principles of Applicant's device. The teachings of Mark relate to delivery of a document or file upon request by a first computer (Marks paragraphs [0008-0010]), which is significantly different from the automatic delivery method of Applicant's device. In fact, Applicant's device specifically avoids the need to request a document, and instead provides automatic delivery of documents that are of particular interest to a user based on predefined subjects. Therefore, it is unlikely that one having ordinary skill in the art at the time of invention would have been successful in modifying the teachings of Murren with the teachings of Marks to successfully achieve Applicant's device as claimed. Thus, because the Examiner has failed to provide an explicit analysis regarding a reasonable expectation of success and because Marks teaches away from Applicant's device, the rejection fails to meet the requirements for *prima facie* obviousness.

Based on the foregoing, the Applicant submits that the rejection to claim 12 is traversed and withdrawal of the rejection is respectfully requested.

Regarding claim 13, the Examiner argues that Murren discloses the system of claim 12, further comprising communication equipment associated with the server for enabling multicast communication with the multiple subscribers over the data network. The Applicant respectfully disagrees with this assessment and submits that the arguments presented above regarding claim 12 apply equally to the rejection of dependent claim 13. As such, the Applicants submit that the rejection of claim 13 has been traversed and withdrawal of the rejection is respectfully requested.

Regarding claim 14, the Examiner argues that Murren discloses the method of claim 6 further comprising instantaneously synchronizing data representative of

the document with remote subscribers at individual sites over the data network. The Applicant respectfully disagrees with this assessment and submits that the arguments presented above regarding claim 6 apply equally to the rejection of dependent claim 14. As such, the Applicants submit that the rejection of claim 14 has been traversed and withdrawal of the rejection is respectfully requested.

Regarding claim 15, the Examiner argues that Murren discloses the method of claim 7 (amended to correctly depend from claim 9) wherein jobs are assigned to subjects. The Applicant respectfully disagrees with this assessment and submits that the arguments presented above regarding claim 6 apply equally to the rejection of dependent claim 15. As such, the Applicants submit that the rejection of claim 15 has been traversed and withdrawal of the rejection is respectfully requested.

#### **IV. Conclusion**

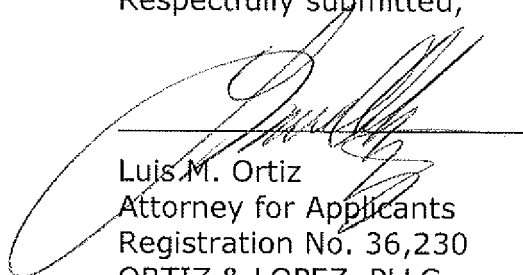
In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action. The Applicant has clarified the structural distinctions of the present invention and now respectfully request the withdrawal of the rejections under 35 U.S.C. §103 based on the preceding remarks. Reconsideration and allowance of Applicant's application is also respectfully solicited.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,

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